

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Application of:	Catherine Lin-Hendel	Confirmation No.:	3830
Serial No.:	09/628,773	Art Unit:	3625
Filed:	July 29, 2000	Examiner:	Haq, Naeem U
For:	<i>System for Interactive Computer-Assisted On-line Auctions</i>	Attorney Docket No.:	101156-5006-US
		Date:	July 22, 2009

**PETITION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. 1.705(d)**

In response to the issuance of the above referenced patent, which issued on June 2, 2009, Applicants submit this petition for patent term adjustment ("PTA") to request a reconsideration of PTA of 542 days.

For consideration of the petition for PTA, enclosed are the following:

1. Fee set forth under 37 C.F.R. § 1.18(e);
2. Statement of the Facts involved under 37 C.F.R. § 1.705(b); and
3. Copy of Patent Term Adjustment History, attached as Appendix A.

In view of the reasons set forth in the Statement of Facts, Applicants respectfully request that the patent term be corrected from the USPTO calculation of 542 days to the Applicant's calculated 1425 days as discussed herein.

### **STATEMENT UNDER 37 C.F.R. 1.705(b)**

This statement is respectfully submitted in support of the Petition For Patent Term Adjustment Under 37 C.F.R. § 1.705(d) for the above-referenced patent. In view of the following, it is respectfully requested that Patentees be granted a final patent term adjustment of 2034 days and not 542 as indicated calculated by the Patent Office.

The Patent Term Adjustment (“PTA”) under 35 U.S.C. § 154(b) listed on the above-referenced patent is 542 days (a copy of the patent term adjustment calculations is submitted herewith in Appendix A). This determination is in error in that pursuant to 35 U.S.C. § 154(b), the Patent Office failed to take certain action within the time frame specified in 35 U.S.C. § 154(b)(1)(A) and 37 C.F.R. § 1.702(a) (Period “A” delay) and failed to issue a patent within three years of the actual filing date of the above-referenced application in accordance with 35 U.S.C. § 154(b)(1)(B) and 37 C.F.R. § 1.702(b) (Period “B” delay).

The District Court for the District of Columbia issued a recent decision on PTA in the case of *Wyeth v. Dudas*, 580 F.Supp.2d 138 (D.D.C. 2008). In that case, the court ruled that patent applicants are entitled to term adjustments for Patent Office delay both under the provision that a patent shall issue within three years of the filing date as well as in instances of further Patent Office delay, such as in issuing an Office Action, so long as both did not occur on the same calendar day. *Id.* at 142.

#### **Period “A” delay:**

Under 35 U.S.C. § 154(b)(1)(A)(i) and 37 C.F.R. § 1.703(a), the Patent Office should have mailed a first Office Action by September 29, 2001 (within fourteen months of filing the application on July 29, 2000). The Patent Office mailed a first Office Action on June 18, 2003, 627 days beyond the September 29, 2001 fourteen month statutory deadline. The Patent Office has properly accounted for this delay of 627 days. (*See attached PTA calculation.*)

Under 35 U.S.C. § 154(b)(1)(A)(ii), the Patent Office should have mailed a response to the Applicant’s May 1, 2006 Request for Continued Examination by September 1, 2006 (within four months.) The response was not mailed until January 23, 2007. The Patent Office has properly accounted for this delay of 144 days. (*See attached PTA calculation.*)

#### **Period “B” delay:**

In addition to the PTA delay in commencing examination, the Patentee respectfully submits that she is also entitled to a period of PTA due to the failure of the Patent Office to issue a patent within three years of filing the application pursuant to 35 U.S.C. § 154(b)(1)(B) and 37 C.F.R. § 1.703(b). As the initial filing of the application was July 29, 2000, three years from the filing of the initial application is

July 29, 2003. The application was not issued until June 2, 2009, almost nine years after the initial filing. Under 35 U.S.C. § 154(b)(1)(B) and 37 C.F.R. § 1.703(b), this additional period of PTA commenced July 29, 2003 (three years after the file of July 29, 2000), and ended June 2, 2009, when the patent issued. This is a total of 2135 days beyond the three year guarantee.

The Applicant also submits that under 35 U.S.C. § 154(b)(1)(B)(i) “any time consumed by continued examination of the application requested by the applicant under section 132(b)” is not included in the period “B” calculation. The Applicant submitted an RCE request on 5/1/06, which eventually resulted in an allowed on 8/5/2008, which is a total of 827 days. The Applicant submitted another RCE request on 12/12/08, which also resulted in an allowance on 1/26/09, which is a total of 45 days. As such the Applicant submits that the total period B delay is  $2135 - 827 = 45$ , for a total of 1263 days of Period B delays.

Periods “A” and “B” do not Overlap:

The patentee submits that the two periods for PTA are not overlapping. The first Period “A” delay of 627 days for the Patent Office’s failure to issue an Office Action within fourteen months of filing the application occurred between September 29, 2001 and June 18, 2003. The PTA of 1263 days for the Patent Office’s failure to issue the patent within three years of filing under 35 U.S.C. § 154(b)(1)(B) occurred between July 29, 2003 and June 2, 2009. As the ending of period “A” was June 18, 2003 and the beginning of period “B” started July 29, 2003, these periods do not overlap.

The second Period “A” delay of 144 days for the Patent Office’s failure to issue an Office Action responding to the Applicants May 1, 2006 Request for Continued Examination occurred between September 1, 2006 and January 23, 2007. No Period “B” time accrues during time consumed by continued examination, therefore no Period “B” time accrued from May 1, 2006 until the eventual allowance in August 5, 2008. As the Period “A” delay of 14 days between September 1, 2006 and January 23, 2007 are entirely within the non-accruing Period “B” timeframe of May 1, 2006 and August 5, 2008, these periods also do not overlap.

Therefore the Period A delays and the Period B delay should be added together. That is a total of 2034 days (1263 days + 627 days + 144 days).

Patentee's own Delay is Subtracted:

The Patentee further submits that according to 37 C.F.R. § 1.703(f) the final PTA should reflect Patentee's own delay. According to the Patent Offices's calculation of the PTA, the Patentee's delay is a total of 609 days. (See attached PTA calculation).

As set forth in 37 C.F.R. § 1.703(f), Patentees are entitled to a period of PTA equal to the period of delays based on the grounds set forth in 35 U.S.C. § 154(b) and 37 C.F.R. § 1.702, reduced by the period of time equal to the period of time during which Patentees failed to engage in reasonable efforts to conclude prosecution pursuant to 37 C.F.R. § 1.704. According to the Patent Office's own calculations, the Patentee's delay was 609 days. Accordingly, Patentees submit that the total patent term adjustment should be Patent Office a total delay of 2034 days, lessened by Patentee's delay of 609 days. This is a total of 1425 days (2034 days – 609 days).

In view of the foregoing, it is respectfully requested that this Petition for Patent Term Adjustment Under 37 C.F.R. § 1.705(d) be favorably considered and that a corrected determination of Patent Term Adjustment be issued to reflect a PTA of 1425 days.

Respectfully submitted,

Date: July 22, 2009

  
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## Appendix A

09/628,773      SYSTEM FOR INTERACTIVE COMPUTER-ASSISTED ON-LINE AUCTIONS      07-10-2009::12:18:19

### Patent Term Adjustments

Patent Term Adjustment (PTA) for Application Number: 09/628,773

Filing or 371(c) Date:	07-29-2000	USPTO Delay (PTO) Delay (days):	1151
Issue Date of Patent:	06-02-2009	Three Years:	-
Pre-Issue Petitions (days):	+0	Applicant Delay (APPL) Delay (days):	609
Post-Issue Petitions (days):	+0	Total PTA (days):	542
USPTO Adjustment(days):	+0	Explanation Of Calculations	

### Patent Term Adjustment History

Date	Contents Description	PTO(Days)	APPL(Days)
05-13-2009	PTA 36 Months	380	
06-02-2009	Patent Issue Date Used in PTA Calculation		
04-27-2009	Dispatch to FDC	↑	
04-24-2009	Issue Fee Payment Verified	↑	
04-24-2009	Issue Fee Payment Received	↑	
04-23-2009	Mail Response to 312 Amendment (PTO-271)	↑	
04-22-2009	Response to Amendment under Rule 312	↑	
04-16-2009	Amendment after Notice of Allowance (Rule 312)		8
01-26-2009	Mail Notice of Allowance		
01-14-2009	Document Verification		
01-14-2009	Notice of Allowance Data Verification Completed		
01-14-2009	Examiner's Amendment Communication		
12-12-2008	Workflow - Drawings Finished		
12-12-2008	New or Additional Drawing Filed		
12-31-2008	Date Forwarded to Examiner		
12-31-2008	Date Forwarded to Examiner		
12-12-2008	Request for Continued Examination (RCE)		
12-31-2008	DISPOSAL FOR A RCE/CPA/129 (express abandonment if CPA)		
12-19-2008	Case Docketed to Examiner in GAU		
01-06-2009	Patent Issue Date Used in PTA Calculation		
12-17-2008	Mail-Record Petition Decision of Granted to Withdraw from Issue		
12-17-2008	Record Petition Decision of Granted to Withdraw from Issue		
12-12-2008	Petition Entered		
12-12-2008	Workflow - Request for RCE - Begin		
11-26-2008	Dispatch to FDC		
11-18-2008	Workflow - Drawings Finished		
11-18-2008	TC Return to Pubs		
11-13-2008	Change in Power of Attorney (May Include Associate POA)		
11-13-2008	Correspondence Address Change		

10-31-2008	Application Is Considered Ready for Issue		
10-30-2008	Issue Fee Payment Verified		
10-30-2008	Issue Fee Payment Received		
08-05-2008	Mail Examiner's Amendment		
08-05-2008	Mail Notice of Allowance		
07-21-2008	Notice of Allowance Data Verification Completed		
07-21-2008	Examiner's Amendment Communication		
05-13-2008	Date Forwarded to Examiner		
04-23-2008	Response after Non-Final Action		
01-25-2008	Mail Non-Final Rejection		
01-22-2008	Non-Final Rejection		
11-21-2007	Miscellaneous Incoming Letter		
11-19-2007	Mail Examiner Interview Summary (PTOL - 413)		
11-15-2007	Date Forwarded to Examiner		
11-05-2007	Response after Non-Final Action		
11-13-2007	Examiner Interview Summary Record (PTOL - 413)		
08-10-2007	Mail Non-Final Rejection		
08-06-2007	Non-Final Rejection		
07-19-2007	Correspondence Address Change		
06-21-2007	Correspondence Address Change		
06-21-2007	Change in Power of Attorney (May Include Associate POA)		
06-21-2007	Correspondence Address Change		
06-01-2007	Date Forwarded to Examiner		
05-22-2007	Response after Non-Final Action		29
05-22-2007	Request for Extension of Time - Granted		↑
01-23-2007	Mail Non-Final Rejection	144	
01-17-2007	Non-Final Rejection	↑	
01-17-2007	Date Forwarded to Examiner	↑	
01-17-2007	Date Forwarded to Examiner	↑	
05-01-2006	Request for Continued Examination (RCE)		537
01-17-2007	DISPOSAL FOR A RCE/CPA/129 (express abandonment if CPA)		↑
12-29-2006	Mail-Petition to Revive Application - Granted		↑
05-01-2006	Petition Entered		↑
05-01-2006	Workflow - Request for RCE - Begin		↑
04-25-2006	Disposal Flag Change		↑
03-02-2006	Mail-Petition Decision - Dismissed		↑
03-13-2006	Disposal Flag Change		↑
12-05-2005	Miscellaneous Incoming Letter		↑
12-05-2005	Petition Entered		↑
03-31-2005	Mail Examiner Interview Summary (PTOL - 413)		↑
03-31-2005	Mail Abandonment for Failure to Respond to Office Action		↑

03-21-2005	Abandonment for Failure to Respond to Office Action		↑
03-21-2005	Examiner Interview Summary Record (PTOL - 413)		↑
08-10-2004	Mail Final Rejection (PTOL - 326)		↑
08-09-2004	Final Rejection		
06-03-2004	Date Forwarded to Examiner		
05-04-2004	Response after Non-Final Action		
06-03-2004	IFW TSS Processing by Tech Center Complete		
05-04-2004	Workflow incoming amendment IFW		
02-04-2004	Mail Non-Final Rejection		
01-26-2004	Non-Final Rejection		
11-13-2003	Date Forwarded to Examiner		
10-23-2003	Response after Non-Final Action		35
10-23-2003	Request for Extension of Time - Granted		↑
06-18-2003	Mail Non-Final Rejection	627	
06-16-2003	Non-Final Rejection	↑	
03-11-2003	Case Docketed to Examiner in GAU	↑	
02-20-2003	Case Docketed to Examiner in GAU	↑	
11-21-2002	Case Docketed to Examiner in GAU	↑	
01-20-2001	Case Docketed to Examiner in GAU	↑	
09-28-2000	Application Dispatched from OIPE	↑	
09-28-2000	Correspondence Address Change	↑	
08-29-2000	IFW Scan & PACR Auto Security Review	↑	
07-29-2000	Initial Exam Team nn	↑	

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